

### **REMARKS**

In view of the continued rejection on the basis of the *Onoda et al.* (Japanese Laid-Open Application 2002-247526), it is believed that an understanding of the advantages of the present invention and the unique market that it is addressing, should first be appreciated for the production and distribution of movies. For example, the sale of DVDs have been generally dominated by movies which are initially produced and distributed in the English language and subsequently distributed in other markets where English is not the native language. There are occasions, however, where a user desires to have a video presentation of the movie with a second language in it, which are not generally distributed in the native country.

The present invention addresses an ability to support a market for such users and more particularly, provides a capability of providing an update kit in a desired language that can be coordinated with the existing video disk. By appropriately providing package management information, a second medium can have a plurality of package areas, each assigned to a different one of a plurality of optical disks. A second digital stream can exist in a specified packaging area.

A download can perform a file transfer protocol communication for example, via an Internet server and download an update kit, for example, on a local hard drive. A volume label, for example in a BD-ROM can be made available to the download unit and can generate, when downloading an update kit, a directory having the same volume label in the hard drive disk. The update kit can be written to the same directory having the same directory name as the volume label.

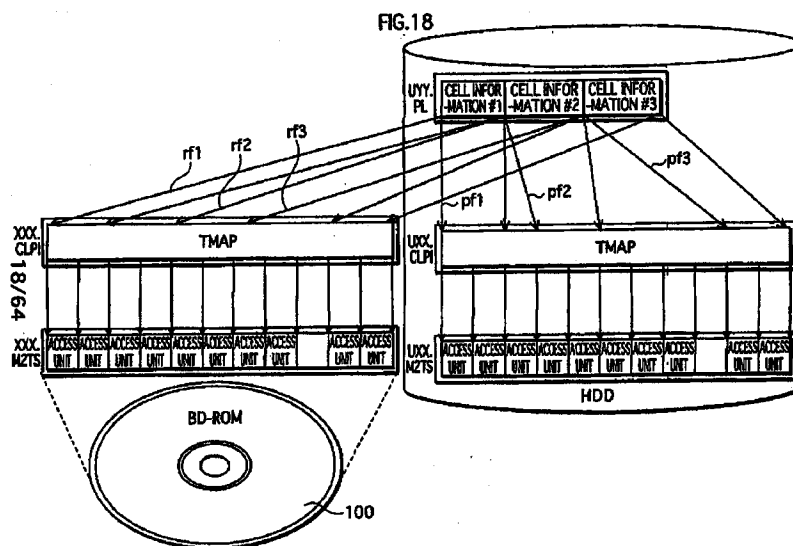
Thus, a secondary recording medium can have a plurality of package areas, each assigned to a different one of a plurality of optical disks. See, for example, our specification, Page 9,

Lines 13-23. Reference can also be made to Figure 19 to disclose a manner in which a control procedure is performed by a control unit with the BD-ROM having the video and audio information, mounted on a playback apparatus and a control unit capable of reading a directory or medium information that matches the read volume label among the plurality of directories in a hard drive from the update kit.

Thus, a packaging area that corresponds to the obtained media information can be accessed, for example in the manner set forth in Figure 19 and as described starting on Page 47, Line 4, as noted in Figure 19, so that an access unit number found in the AV stream on both the BD and the HD can include a point video frame of a cell number. This correlation can be established between the video frame on the BD and a plurality of AV streams that can then be played back in synchronization with one another as a result of the update kit recorded in the HD buffer. See, for example, steps 8, 9 and 10 in Figure 19 where a decision can be made as to whether the audio number is on the BD and is subsequently executed or can be accessed through the HD buffer to the audio decoder.

An explanation can further be found starting on Page 40, Line 25, through Page 41, Line 17, wherein one AV stream number 1 is recorded on the BD-ROM as the English audio and is coordinated with the moving pictures or video. A second AV stream number 2 is recorded, for example, on a hard drive and includes the Japanese audio language as a second language. Since the Japanese audio is stored in an AV stream different from the one in which the video is stored, that is on the BD-ROM, it is possible to distribute the Japanese audio in an update kit, for example over the Internet, as a secondary market that can expand the use of the original BD-ROM while assuring adequate correlation to enable users to view the movie production version in sync with a Japanese audio of the video content.

Applicant respectfully submits that the principally relied upon *Onoda et al.* reference does not address nor even recognize the possibility of serving such a secondary unique market with update kits that are provided via an AV stream that can be recorded on a secondary recording medium (hard disk) and then played back by a control unit programmed to coordinate, for example as shown in the schematic of our Figure 18, between the audio stream recorded in an optical disk that is BD-ROM 100 and an AV stream, for example of a second language, that can be downloaded and recorded on a secondary recording medium (hard disk), HDD.



The Office Action contended that Claims 67, 68, 70-76 and 78-86 were completely anticipated by the *Onoda et al.* reference.

“[A]nticipation by inherent disclosure is appropriate only when the reference discloses prior art that must *necessarily* include the unstated limitation. . . .”

*Transclean Corp. v. Bridgewood Services, Inc.*, 290 F.3d 1364, 62 USPQ2d 1865 (Fed. Cir. 2002)

The Office Action contended the *Onoda et al.* reference taught coordinating an external stream and audio and sub-picture stream data that was input through a channel of an external input unit 62 shown in Figure 1.

The system clock unit 22 is synchrony with a system time clock reference data, presumably from the synchronicity control unit 21 and is utilized to control the overall actions of the device as defined in Paragraphs 0010 and 0011. Thus, the decoding unit 61 as shown in Figure 1 with a dotted line, is provided with a presentation time stamp that has been decoded from the management information and modulated by the synchronicity control unit 21. Purportedly the decoding unit 61 compares a presentation time stamp of the external stream data with the presentation time stamp of the video stream data for feeding the exterior stream data such as audio to the selector 40.

As shown in Figure 2, the hierarchal structure of the video object (VOB) is shown and a presentation time stamp is provided with each pack in coordination with the system clock 22.

The teaching of an integration of the external stream is of limited scope as defined, for example, in Paragraph 0035, namely if a stream end exists beyond the decoded management information of stream numbers 1 through M, the system control unit then controls the selection state of the selector 40, so that an external audio stream or sub-picture stream is sent to the appropriate decoder 32 or decoder 33. As noted in Paragraph 0037 the external stream of audio or sub-picture information has to have a packet structure shown in Figure 3 with a PTS specifically scripted for the timing information for achieving synchronicity with the video packet of the currently played DVD. The external source must be coordinated and synchronized to both the internal standard time or system clock and the video packet in order to be operative.

The Office Action objected to Claim 84 under the first paragraph of 35 U.S.C. §112 by contending that there was no support in our specification that would teach a person of ordinary skill in the field that a computer readable recording medium was set forth in our specification. Applicant respectfully traverses this contention and, referring to applicant's published U.S. Patent Application 2006/0098936, reference can be made to Paragraph 0151 which refers to our control unit 16 as a typical computer system that includes a CPU with capacity to play back data recorded on a BD-ROM which is a computer readable recording medium. See further the description set forth in Paragraphs 0300 through 0308.

Additional reference can be made to Paragraphs 0144 through 0146 where it is clearly defined that a local hard drive is provided with the update kit, which can be read by the computer. Again, this is a computer readable recording medium storing a program.

The amendment to our claims is supported by our specification, for example the amendment to Claim 68 "package area corresponding to optical disks" and "a plurality of package areas assigned to a plurality of optical disks" can be found in Paragraphs 0023 and 0024. Additionally, appreciation of the operation can also be found in Paragraphs 0145 through 0148.

As can be readily appreciated, the *Onoda et al.* reference does not disclose nor suggest a plurality of package areas nor assignments to a plurality of optical disks.

Claim 68 has also been amended to define "out of the plurality of package areas in the secondary recording medium" and support can be found, for example in Figure 19 and the description starting at Paragraph 0175.

The *Onoda et al.* reference does not disclose nor suggest “the obtained media information” nor specify “out of the plurality of package areas in the secondary recording medium, a package area that corresponds to the obtained media information.”

It would appear that *Onoda et al.* as discussed above, must have a PTS correlation directed to the original optical disk carrying the movie data. Reference can be made, for example, to Paragraph 0165.

As can be appreciated, the time stamp in the *Onoda et al.* reference does not identify “the first digital stream in correspondence with the second digital stream.” Additionally, the “play list information” has been modified in Claim 71, to refer to the “corresponding information” as mentioned above.

The present invention differs from the *Onoda et al.* reference in how a secondary stream is selected for synchronous playback with a digital stream on a recording medium. According to the *Onoda et al.* reference, the stream to be synchronized is selected based on information (i.e., PGCi: Program Chain Information) recorded on the DVD video disc, which is an optical disc. Paragraph 0032 cited by the Office Action states that the DVD video disc 11 stores the video title set PGCi table for managing the video stream as a Title. The general information included in the video title set PGCi table includes an audio stream control information table and a sub-picture stream control information table. The audio stream control information table includes (i) flags each indicating whether or not the respective audio streams are valid within the current program chain and (ii) the stream numbers. Similarly, the sub-picture stream control information table includes (i) flags each indicating whether or not the respective sub-picture streams are valid within the current program chain and (ii) the stream numbers corresponding to the display aspects (4:3, wide, and letter box). With reference to the management information shown in

Figure 4, the system control unit 50 can, therefore, acknowledge the number of audio streams and the number of sub-picture streams contained in the currently played DVD video disc.

That is, the PGCI includes the stream numbers 1-M each indicating a different one of the audio streams recorded on the DVD video disc 11, which is an optical disc. In response to a user operation of selecting a stream number that falls within the range of 1 and M, the corresponding audio stream recorded on the DVD video disc 11 is read. On the other hand, in response to a user operation of selecting a stream number N that is greater than M ( $N > M$ ), an external audio stream supplied via the network or another medium is read (see Paragraph 0035). Therefore, the stream to be synchronized is not selected, according to any correspondence information.

The present invention further differs from *Onoda et al.* in that the *Onoda et al.* reference lacks any information that associates the stream recorded on the optical disc with an external stream not recorded on the optical disc. The Office Action cites Paragraph 0031 and alleged playlist information is disclosed. However, the cited Paragraph actually discloses a video title set PGCI table that includes PGCI.

The PGCI designates cell playback information (C\_PBI) that specifies the head address of the first VOB in the cell and the head address of the last VOB in the cell. The system control unit 50 therefore controls the servo unit 18 and the motor 12 to read data from the optical disc in a manner to acquire VOBs constituting the cell as defined by the cell playback information. That is to say, the head address of the first VOB in the cell and the head address of the last VOB are used to control the servo unit 18 and the motor 12. The respective addresses are not for an audio or sub-picture stream recorded on an external medium to be synchronously played with the VOBs recorded on the optical disc.

The Office Action also rejected Claim 69 over the *Onoda et al.* reference when further taken in view of *Hamasaka et al.* (U.S. Patent No. 7,356,247) under 35 U.S.C. §103. The Office Action acknowledged that *Onoda et al.* failed to teach corresponding information including one or more pieces of starting point information and ending point information in the first digital stream in correspondence with a starting point and ending point in the second digital stream.

The Office Action further acknowledged that the playback apparatus failed to include a playback control unit that can interpret the readings in the first and second reading units and playback based on the result of this interpretation.

Thus, the *Hamasaka et al.* reference was cited for its teaching of “correspondence information.”

More specifically, the *Hamasaka et al.* reference was cited for its teaching of Column 21, Line 55 through Column 22, Line 5 as follows:

The user then instructs DVD recorder 1900 to mark the selected entry point (step S323). When an entry point marking command is received from the user, system controller 1902 of DVD recorder 1900 adds an entry to the user-defined entry point table (step S324). If the user wants to set an entry point to a location other than the original entry points, the starting and end points of the stream interval to be marked by an entry point must be specified. Based on the indicated starting point, system controller 1902 of DVD recorder 1900 then retrieves the presentation time stamp (PTS) corresponding to the specified starting point. System controller 1902 then adds an entry to the user-defined entry point table and records the detected presentation time stamp (PTS) to the end time field EP-PTM. Note that the USER-EP flag of the entry point table is set if two different entry point tables such as shown in FIG. 15 are not used and automatically set entry points and user-defined entry points are managed in a single table such as shown in FIG. 14.

As can be determined, this patent is assigned to the present assignee and shares an inventor, Hiroshi Hamasaka.



The *Hamasaka et al.* reference addresses an issue in recording AV data and mentions setting an entry point in an MPEG format and more specifically, providing a capability of separately identifying a set entry point from other entry points such as that automatically recorded by a disk recorder.

In essence, the user is provided a relatively simplified form of management information to permit recording video data from different sources on the same disk, and particularly the capability of managing AV streams “independently of the AV data format.” See Column 5, Lines 61-64.

In essence, the *Hamasaka et al.* system can record and play a stream of encoded digital data while having a controller generate management information that basically records a time at which a change in an attribute of a stream of encoded digital data is detected. The first entry point defines when the encoded digital data is operable to begin playing. A second entry point is created by the user and can be at any point within the stream of the encoded digital data in which the encoded digital data is operable to be in play. The user can then select user defined access points in which the user wishes to have an integration of a separate AV stream, as shown for example in Figure 5.

As can be appreciated, this is not suggestive of a secondary recording medium with corresponding information recorded thereon, for identifying a first digital stream in correspondence with a second digital stream, nor of the concept of a packaging area corresponding to an optical disk out of a plurality of packaging areas. A secondary recording medium of this type is certainly neither taught nor suggested, nor does the overall management information of a higher hierarchal level in the *Hamasaka et al.* reference, teach or suggest the specific features set forth in our current claims.

As can be appreciated, this is a relatively crowded and impacted area with skilled engineers trying to provide improved user features to secure a competitive advantage.

“Thus when differences that may appear technologically minor nonetheless have a practical impact, particularly in a crowded field, the decision-maker must consider the obviousness of the new structure in this light.”

*Continental Can Co. USA Inc. v. Monsanto Co.*, 20 U.S.P.Q. 2d. 1746, 1752 (Fed. Cir. 1991).

It is respectfully submitted that the *Hamasaka et al.* reference could only be found in hindsight from the teachings of our present application.

A recent discussion with Pinchus Laufer in the Office of Patent Legal Administration, who was involved in writing the Examination Guidelines for Determining Obviousness under 35 USC §103 in view of the Supreme Court decision in *KSR International Co. vs. Teleflex, Inc.* verified that the KSR decision still required a specific rationale that could not be based on hindsight for purportedly combining the elements in the prior art to meet an invention defined in the patent claims.

Mr. Laufer incorporated the following from the existing MPEP into the Guidelines.

As noted in the MPEP at §2143.02:

A rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1395 (2007); *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). (underline added)


Combining the teachings of the *Onoda et al.* reference with that of the *Hamasaka et al.* reference would not produce the same functioning nor structural advantages now defined in our current claims.

Accordingly, it is believed that applicant has more than adequately demonstrated the patentability of the present invention.

If the Examiner believes that a telephone interview will assist in the prosecution of the present case, the undersigned attorney can be contacted at the listed phone number.

Very truly yours,

**SNELL & WILMER L.L.P.**



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